

REMARKS

The Office Action dated December 12, 2007, and the patents relied on therein have been carefully reviewed, and in view of the above changes and following remarks reconsideration and allowance of all the claims pending in the application are respectfully requested.

Claims 1, 2, 4-11, 14, 15, 18, 21, 23-31 and 34 stand rejected. Claim 3 has been previously canceled. Claims 35 and 36 have been allowed. Claims 12, 13, 16, 17 19, 20, 22, 32 and 33 have been indicated as containing allowable subject matter and would be allowable if rewritten to include all of the limitations of the respective base claims and any intervening claims.

By this Response, no claims have been amended. Claims 1, 2 and 4-36 remain pending.

The Rejection Under 35 U.S.C. § 103(a) Over Herdal In View of Redman

Claims 1, 5-11, 14, 15, 18, 23-25, 28-31 and 34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Herdal, U.S. Patent No. 3,175,230, in view of Redman, U.S. Patent No. 4,091,481.

Applicants respectfully traverse this rejection. Applicants respectfully submit that that the subject matter according to any of claims 1, 5-11, 14, 15, 18, 23-25, 28-31 and 34 is patentable over Herdal in view of Redman.

In particular, Applicants respectfully submit that the Examiner has not presented a convincing line of reasoning as to why an artisan would have found the claimed subject matter of the present patent application to have been obvious in light of the teachings of Herdal and Redman because (1) the Examiner's modification of Herdal is improper, and (2) if the combination of Herdal and Redman is formed, the resulting device is not the claimed subject matter of any of claims 1, 5-11, 14, 15, 18, 23-25, 28-31 and 34.

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). (See, also, MPEP §§ 706.02(j) and 2144.)

In the present instance, the Examiner does not state that either Herdal or Redman expressly or impliedly suggests the claimed subject matter. Consequently, the Examiner must be relying on the Examiner's proffered line of reasoning to support the present rejection. Accordingly, the Examiner's line of reasoning must be convincing as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the Herdal and Redman.

The Examiner asserts that Herdal discloses "at least one item removably situated in said first cavity" and relies on column 1, lines 20-22 of Herdal as support for this assertion. The Examiner then asserts that the "first cavity sidewall perimeter surface of Herdal billows inward toward said first cavity (fig. 2) and capable of frictionally yet releasably holding at least one item." (See Office Action dated December 12, 2007, page 3, lines 13-15, underlining supplied.)

Applicants respectfully submit that when the true context of Herdal is not ignored, it is plain to see that the Examiner is improperly modifying Herdal. In particular, column 1, lines 7-11, of Herdal discloses that "[t]his invention relates to a bolster for night wear and has as its primary object the provision of an ornamental bolster provided with a relatively rigid frame surrounding a central cavity, in which night wear may be folded and stored." Additionally, column 1, lines 18-22, of Herdal discloses "[a] further object of the invention is the provision of a device of this character having a stiff or relatively firm framework surrounding the cavity so that the night wear contained therein will not become mussed or crumpled when retrieved." Thus, the true context of Herdal is that a user of a Herdal bolster would have the full intention and expectation of folding and storing night wear in the bolster so that the night wear would not be "mussed or crumpled when retrieved." In contrast, the Examiner appears to be asserting that a user of a Herdal bolster would have the full intention and expectation of cramming night wear into the bolster so that the bolster frictionally yet releasably holds the night wear, and without any concern with the night wear becoming "mussed or crumpled when retrieved."

Applicants respectfully submit that the Examiner's improper modification of Herdal changes the principle of operation of Herdal. That is, the Examiner's improper modification of Herdal so that a Herdal bolster frictionally yet releasably holds night wear without a user being concerned with the night wear being "mussed or crumpled when retrieved" changes the operation of Herdal. Such a change in the principle of operation is contrary to the actual disclosure and true context of Herdal, and is contrary to *In re Ratti*, 270 F.2d.810,

123 USPQ 349 (CCPA 1959). (See, also, MPEP § 2143.01.)

Moreover, Applicants respectfully submit that it is notable that the Examiner has not attempted to explain away the true context of Herdal, particularly in view of the fact that Applicants have previously raised this issue about the Examiner's improper modification of Herdal with respect to claim 1. Accordingly, Applicants respectfully submit that the failure of the Examiner to address this previously raised issue demonstrates that the Examiner is ignoring the true context of Herdal. Thus, Applicants respectfully submit that the only way such a modification of Herdal is possible is by plainly ignoring the true disclosure and context of Herdal.

Applicants respectfully submit that the Examiner's improper modification of Herdal in order to change of operation of Herdal is used by the Examiner to assert that the "first cavity sidewall perimeter surface of Herdal billows inward toward said first cavity (fig. 2) and capable of frictionally yet releasably holding at least one item." Applicants respectfully submit that the nexus used by the Examiner to assert that the Herdal bolster is "capable of frictionally yet releasably holding at least one item" is actually nothing more than a hindsight reconstruction of the claimed subject matter using Applicants' disclosure as a template to improperly modify Herdal.

Regarding Redman, Applicants respectfully note that the Examiner is still silent with respect to Redman disclosing or suggesting at least one item frictionally yet releasably situated in the claimed first cavity such that the claimed first cavity sidewall perimeter surface billows inward toward the first cavity to frictionally yet releasably hold the claimed at least one item. This is not surprising because Redman is silent in this regard.

In view of the Examiner's improper modification of Herdal and the Examiner's proffered line of reasoning for combining (improperly modified) Herdal and (silent) Redman to form the claimed subject matter, Applicants respectfully submit that the Examiner's line of reasoning is not convincing as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of Herdal and Redman. As demonstrated, the Examiner's line of reasoning does not result in the claimed subject matter of claim 1 because neither Herdal nor Redman disclose or suggest the claimed at least one item frictionally yet releasably situated in the claimed first cavity such that the claimed first cavity sidewall perimeter surface billows inward toward the first cavity to frictionally yet releasably hold the claimed at least one item.

Thus, claim 1 is allowable over Herdal in view of Redman. It follows that claims 5-11, 14, 15 and 18, which incorporate the features of claim 1, are each allowable over Herdal in view of Redman for at least the same reasons that claim 1 is considered allowable.

Regarding claim 23, Applicants respectfully submit that claim 23 is allowable over Herdal in view of Redman for reasons that are similar to the reasons that claim 1 is considered allowable. In particular, Applicants respectfully submit that the Examiner's line of reasoning is not convincing as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of Herdal and Redman because neither Herdal nor Redman disclose or suggest at least the claimed first cavity sidewall perimeter surface billowing toward the claimed three dimensional void, at least when the claimed void is empty, for frictionally yet releasably receiving the claimed item. As demonstrated above, the Examiner is improperly modifying Herdal by changing the principle of operation of Herdal, which is contrary to *In re Ratti*, 270 F.2d.810, 123 USPQ 349 (CCPA 1959). (See, also, MPEP § 2143.01.) Further, Redman is silent in this regard. Thus, claim 23 is allowable over Herdal in view of Redman. It follows that claim 24, which incorporates the features of claim 23, is allowable over Herdal in view of Redman for at least the same reasons that claim 23 is considered allowable.

Regarding claim 25, Applicants respectfully submit that claim 25 is allowable over Herdal in view of Redman for reasons that are similar to the reasons that claim 1 is considered allowable. More specifically, Applicants respectfully submit that the Examiner's line of reasoning is not convincing as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of Herdal and Redman because neither Herdal nor Redman disclose or suggest the claimed item frictionally yet releasably stationed in the claimed cavity by the cavity sidewall perimeter layer. As demonstrated above, the Examiner is improperly modifying Herdal by changing the principle of operation of Herdal, which is contrary to *In re Ratti*, 270 F.2d.810, 123 USPQ 349 (CCPA 1959). (See, also, MPEP § 2143.01.) Further, Redman is silent in this regard. Thus, claim 25 is allowable over Herdal in view of Redman. It follows that claims 28-31, which incorporate the features of claim 25, are each allowable over Herdal in view of Redman for at least the same reasons that claim 25 is considered allowable.

Regarding claim 34, Applicants respectfully submit that claim 34 is allowable over Herdal in view of Redman for reasons that are similar to the reasons that claim 1 is considered

allowable. In particular, Applicants respectfully submit that the Examiner's line of reasoning is not convincing as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of Herdal and Redman because neither Herdal nor Redman disclose or suggest at least the claimed at least one item frictionally yet releasably situated in the claimed first cavity by the first cavity sidewall perimeter surface. As demonstrated above, the Examiner is improperly modifying Herdal by changing the principle of operation of Herdal, which is contrary to *In re Ratti*, 270 F.2d.810, 123 USPQ 349 (CCPA 1959). (See, also, MPEP § 2143.01.) Further, Redman is silent in this regard. Thus, claim 34 is allowable.

The Examiner cites *In re Fine*, 837 f.2d 1071, 5 USPQ2d 1596 (Fed. Cir 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir 1992) for the proposition of law that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggesting, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Applicants respectfully note that in both *In re Fine, supra*, and *In re Jones, supra*, the Court of Appeals for the Federal Circuit (CAFC) reversed the decision of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office affirming the Examiner's final rejection. In particular, in *In re Fine, supra*, the CAFC indicated that there was nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention and that there was no offered support for the conclusion that "substitution of one type of detector for another in the system of Eads would have been within the skill of the art." Similarly, in *In re Jones, supra*, the CAFC indicated that there was no evidence in the record that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at Jones' claimed invention.

Applicants respectfully submit that in this particular instance the Examiner has similarly failed to specifically identify a teaching, suggestion or motivation in either Herdal and Redman to combine and/or modify Herdal and Redman to produce the claimed subject matter. Further, the Examiner has not identified knowledge generally available to one of ordinary skill in the art that would modify Herdal and Redman to produce the claimed subject matter. Instead, the Examiner has improperly modified Herdal by changing the principle of operation of Herdal to arrive at the subject matter of claims 1, 23, 25 and 34, which is contrary to *In re Ratti*, 270 F.2d.810, 123 USPQ 349 (CCPA 1959). (See, also, MPEP § 2143.01.)

The Examiner also cites *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981) for the proposition of law that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In this particular instance, Applicants wish to respectfully remind the Examiner of this same proposition of law when the Examiner improperly modifies Herdal so that a user of a Herdal bolster would thereby expect to have night wear contained therein become mussed or crumpled when retrieved. Such a modification plainly changes the principle of operation of Herdal. *In re Ratti*, 270 F.2d.810, 123 USPQ 349 (CCPA 1959). (See, also, MPEP § 2143.01.)

Accordingly Applicants respectfully submit that it is only by impermissible hindsight that the Examiner is able to reject claims 1, 5-11, 14, 15, 18, 23-25, 28-31 and 34 based on the combination of Herdal in view of Redman. The Examiner does not state that either Herdal or Redman expressly or impliedly suggest the claimed subject matter. Moreover, the Examiner has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of Herdal and Redman. In particular, the Examiner improperly modifies the principle of operation of Herdal to arrive at the claimed subject matter. It is only by using Applicants' disclosure as a template that the Examiner is able to select particular features of Herdal and Redman through a hindsight reconstruction of Applicants' claims to make the rejection.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claims 1, 5-11, 14, 15, 18, 23-25, 28-31 and 34

**The Rejection Under 35 U.S.C. § 103(a) Over Herdal
In View of Redman And Further In View Of Saarela**

Claims 2 and 26 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Herdal in view of Redman as applied to claims 1, 5-8, 10, 15, 23-25, 28, 29 and 31 and further in view of Saarela et al. (Saarela), U.S. Patent No. 5,788,468.

Applicants respectfully traverse this rejection. Applicants respectfully submit that Saarela does not cure the deficiencies of Herdal and Redman with respect to claims 1 and 25, the respective base claims of claims 2 and 26.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claims 2 and 26.

**The Rejection Under 35 U.S.C. § 103(a) Over Herdal
In View of Redman And Further In View Of Gervaise**

Claims 4 and 27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Herdal in view of Redman as applied to claims 1, 5-8, 10, 15, 23-25, 28, 29 and 31 and further in view of Gervaise, U.S. Patent No. 3,378,948.

Applicants respectfully traverse this rejection. Applicants respectfully submit that Gervaise does not cure the deficiencies of Herdal and Redman with respect to claims 1 and 25, the respective base claims of claims 4 and 27.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claims 4 and 27.

**The Rejection Under 35 U.S.C. § 103(a) Over Herdal
In View of Redman And Further In View Of Perez-Mesa**

Claim 21 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Herdal in view of Redman as applied to claims 1, 5-8, 10, 15, 23-25, 28, 29 and 31 and further in view of Perez-Mesa et al. (Perez-Mesa), U.S. Patent No. 6,105,188.

Applicants respectfully traverse this rejection. Applicants respectfully submit that Perez-Mesa does not cure the deficiencies of Herdal and Redman with respect to claim 1, the base claim of claim 21.

Consequently, Applicants respectfully request that the Examiner withdraw this rejection and allow claim 21.

Allowable Subject Matter

Applicants respectfully acknowledge that the Examiner has indicated that claims 35 and 36 have been allowed, and that claims 12, 13, 16, 17 19, 20, 22, 32 and 33 have been indicated as containing allowable subject matter and would be allowable if rewritten to include all of the limitations of the respective base claims and any intervening claims. Applicants respectfully submit that this subject matter should still be allowable.

Applicants note that additional patentable distinctions between Herdal, Redman, Saarela, Gervaise, Perez-Mesa and the rejected claims exist; however, the foregoing is believed sufficient to address the Examiner's rejections. Additionally, failure of Applicants to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Applicants do not agree.

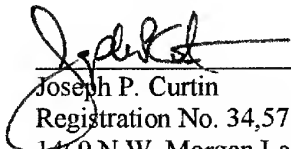
CONCLUSION

In view of the above amendments and arguments, it is urged that the present application is now in condition for allowance. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below.

It is requested that this application be passed to issue with claims 1, 2 and 4-36.

Respectfully submitted,

Date: March 11, 2008



Joseph P. Curtin
Registration No. 34,571
1469 N.W. Morgan Lane
Portland, OR 97229-5291
(503) 296-8373
(503) 297-0452 (facsimile)